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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,079	04/22/2005	Jamila Najib	BJS-3665-129	9192
23117 7590 06/08/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
LOEWY, SUN JAE Y				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
06/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,079

Applicant(s)

NAJIB ET AL.

Examiner

SUN JAE Y. LOEWE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-90,92-99,101,102 and 104-106 is/are pending in the application.
- 4a) Of the above claim(s) 71-73,75,76,81-84,88-90,94,95,98 and 104-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69,70,74,77,80,85-87,92,93,96,97,99,101,102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :4-29-2009;12-31-2008;11-19-2008.

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DETAILED ACTION

1. Claims 69-90, 92-99, 101, 102 and 104-106 are pending in the instant application.

Claims 71-73, 75, 76, 81-84, 88-90, 94, 95, 98 and 104-106 are withdrawn.

Election/Restrictions

2. Applicant's election with traverse of Group I, and species of

1-[4-methylthiophenyl]-3-[3,5-dimethyl-4-carboxydimethylmethoxyphenyl]prop-2-en-1-one in the reply filed on March 18, 2009 is acknowledged. The traversal is on the ground(s) that lack of unity has not been shown. This is not found persuasive because lack of unity was shown, as referenced, in the restriction requirement dated February 28, 2007.

The requirement is still deemed proper and is therefore made FINAL.

3. Pursuant MPEP 1893.03

“(Excerpts)

Once the national stage application has been taken up by the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that:

(A) the international filing date >(or, if appropriate, the priority date)< is the date to keep in mind when searching the prior art; and

(B) unity of invention proceeds as under 37 CFR 1.475.

.....

¶ 18.30 National Stage Election of Species in 35 U.S.C.

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371. Applications

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

[1]

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a) ”

the search and examination detailed in this office action was performed following the guidelines provided by MPEP 803.02

“(Excerpts)”

Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable **, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration.”

The elected compound was not allowable. Therefore, the provisional election of species was given effect and non-elected species were withdrawn from further consideration.

4. Claims 71-73, 75, 76, 81-84, 88-90, 94, 95, 98 and 104-106 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject

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matter. Applicant timely traversed the restriction requirement in the response filed on March 18, 2009.

Information Disclosure Statement

5. The information disclosure statements (dated November 19, 2008; December 31, 2008 and April 29, 2009) were in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The statements were considered. Signed copies of form 1449 are enclosed herewith.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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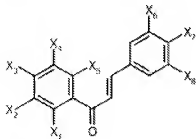
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 69, 70, 74, 77, 80, 85-87, 92, 93, 96, 97, 99, 101 and 102 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19, 30, 31 and 34-38 of US Appl. 10/585,329 (U.S. Patent No. 7,547,729). Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons provided below.

Determination of the scope and contents of claims 19, 30, 31 and 34-38 of US Appl. 10/585,329

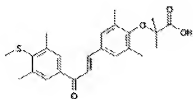
The claims are drawn to a Markush group of compounds



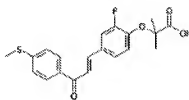
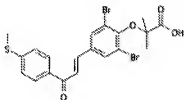
that have the same utility as instantly claims.

The following preferred embodiment is claimed

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The following additional embodiments are disclosed:



Ascertaining the differences between claims 19, 30, 31 and 34-38 of US Appl. 10/585,329 and the claims at issue.

The preferred embodiment claimed is a homologue of the instantly elected species.

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.

MPEP § 2144.08.II.A.4(c) states "...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties". This is a "Genus-Species Guidelines" for the examination based on 35 U.S.C. 103. An analogous guideline was followed here for the analysis of obviousness-type double patenting.

To those skilled in chemical art, one homologue is not an advance over an adjacent member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of series, would know what properties to expect in adjacent members. In *re Henze*, 85 USPQ 261 (1950). In *re Wood*, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and In *re Lohr*, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963).

One of ordinary skill would be motivated to make the instant elected species, which is a homolog of the claimed preferred embodiment with reasonable expectation of success for obtaining an additional compound for the same utility. The disclosure of additional PPAR agents (eg. see embodiments noted above) further motivates one of ordinary skill to make the instant election. The motivation would be to make an additional compound for the claimed purpose.

The preferred embodiments suggest to one of ordinary skill to practice the instantly claimed invention. Thus, the instant claims are *prima facie* obvious over claims 19, 30, 31 and 34-38 of US Appl. 10/585,329.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe/
6-3-2009

/Joseph K. McKane/
Supervisory Patent Examiner, Art Unit 1626